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IN THE

Supreme Court of the United States,

OCTOBER TERM, A. D. 1884.

No. 227.

WESTERN ELECTRIC MANUFACTURING COMPANY

vs.

ANSONIA BRASS AND COPPER COMPANY.

Appeal from the Circuit Court of the United States, for the District of Connecticut.

BRIEF FOR APPELLANT.

GEORGE P. BARTON,

FOR APPELLANT.

BARNARD & GUNTHORP, LEGAL PRINTERS 104 RANDOLPH STREET, CHICAGO.

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STATEMENT OF THE CASE.

I.

This is a suit in equity brought by the Western Electric Manufacturing Company, a corporation of Chicago, Illinois, against the Ansonia Brass and Copper Company, a corporation of Connecticut, for alleged infringement of reissue letters patent Nos. 6,954 and 6,955, granted complainant as the assignee of Joseph Olmsted, February 29, 1876, for improvements in insulating telegraph wires. The reissues are divisions of original patent 129,858, of July 23, 1872.

Fol. 28. The reissues were introduced in evidence as "Complainant's Exhibit Product Patent," and "Complainant's Exhibit Process Patent."

These patents are identical except as to claims.

The claim of the "Product Patent" is:

Fol. 37. "An insulated telegraph wire, the covering of which has its pores filled and its surface polished, substantially as described."

The claim of the "Process Patent" is:

Fol. 41. The method of insulating telegraph wires, by first filling the pores of the covering, and subsequently compressing that covering, and thereby polishing its surface, substantially as described."

The descriptive part of the specification is as follows:

Fol. 36. "The method of insulating now in use consists in braiding over the wire a fibrous covering, after which it is dipped in wax for the purpose of filling and closing the pores, and, after a subsequent scraping to remove the surplus wax, it is ready for use.

"This method is, however, objectionable, inasmuch as it leaves the covering in a very rough and soft condition, and fails to secure perfect insulation.

"In my improved method, after the wire has received its coating I dip it in paraffine or wax, after which, instead of scraping off the surplus coating, I pass the whole through a suitable machine, which compresses the covering and forces the paraffine or wax into the pores, and secures perfect insulation. By so compressing the covering the paraffine or wax is forced into the pores, and the surface becomes and appears polished.

Fol. 37. "Wire insulated in this manner is entirely impervious to the atmosphere, of greater durability, and less cumbersome than any heretofore made."

The article then which is described and claimed is a telegraph wire covered with a fibrous coating, the fibrous

coating being saturated with paraffine or wax, and the whole being compressed so as to fill the pores of the fibrous covering with the plastic paraffine and make the surface smooth and polished.

The process claimed consists of certain steps in a certain order, which may be stated as follows:

First, applying a fibrous cover to the naked wire; second, immersing the wire thus covered in hot paraffine; third, allowing the paraffine to cool, so as to become plastic; and, fourth, passing the whole through a machine which compresses the covering and forces the plastic paraffine into the pores of the fibrous covering and polishes the surface, thus securing perfect insulation.

As the reissue patents were granted to the electric company no question as to title arises.

The original patent is not in the record.

INFRINGEMENT.

Infringement on the part of the Brass Company was clearly proven.

Witness *Putnam* testifies that he purchased Exhibit Blue Wire, and Exhibit Red and White Wire of defendant May 14, 1880. This was prior to the filing of the complainant's bill, which was July 5, 1880. Fol. 21.

The word "April," next to last line, page 2 of record, is a misprint. It should be "July."

By Mr. WOOSTER: "Defendant admits that paraffine and wax are used by them as component parts of the material used for insulating wire manufactured by them." Fol. 22.

Frank L. Pope, expert for the electric company testi-

fies, on pages 14 and 15, as follows, concerning exhibits introduced by Putnam:

Fol. 25. "6th Int. Please look upon the spool and coil of wire now shown you, being respectively marked complainant's Ex., Blue Wire, W. J. M., Nov. 16, 1880, and complainant's Ex., Red and White Wire, W. J. M., Nov. 16, 1880, and give your opinion as to the method or process by which the said wire was coated or insulated, and give your reasons at length for the opinion you may express.

"A. The wire in both these exhibits has been coated with fibrous material, which has been put on by different methods. The blue wire has two spiral coatings, one outside of the other, one being laid on with a right-hand and the other with a left-hand twist.

"The coating of the red and white wire has been put on by a braiding machine. The subsequent manipulation of both the wires has apparently been the same, and my opinion is that the wire after having been thus coated with fibrous material, has been immersed in a bath of liquid paraffine, wax, or other similar material, and that after this material has more or less solidified the wire has been passed through a cylindrical die whose diameter is
Fol. 26. somewhat less than that of the wire with its coating as it left the coating machine, which has rendered it very nearly uniform in diameter throughout its length and truly cylindrical in form, and has compressed the wax or other like material while in a solid state—or, more properly, a somewhat plastic state—into the interstices of the fibrous material. I have examined the coating in both the exhibits with a magnifying glass, and I find the surface of the coating very smooth and uniform, and having the loose fibres, which ordinarily project in various directions, from the surface, laid, for the most part, parallel to each other and pressed into the wax, thus proving that the coated wire has been subjected to some process similar to that of being passed through a die. An ordinary braided coating, as it comes from the machine, varies in its thickness at different points, to an extent perceptible to the eye and still more perceptible by careful measurement. The diameter being practically uniform in the exhibits shows that the diameter of the die must have been somewhat less

than the average diameter of the coating as it originally came from the covering machine. The polished appearance of the surface shows that this operation must have been performed after the wax had become solidified.

"7th Int. Please look upon the letters patent now shown you, being reissues No. 6,954 and No. 6,955 respectively, for improvement in insulating telegraph wires, granted to the Western Electric Manufacturing Company of Chicago, Illinois, the 29th day of February, 1876, as the assignee of Joseph Olmstead, of Providence, Rhode Island, and state whether you have examined and understand the same, and distinguish the former, the specification of which is marked Division A, from the latter, the specification of which is marked Division B?

"A. I have read the specifications and claim of each of the said reissued patents, and believe that I understand them. The subject-matter of the patent designated as Division A I understand to be an art or process of insulating telegraph wire, which consists of three steps: First, placing a fibrous cover on the wire; second, filling the pores of the cover with paraffine or wax as an insulating material; and, third, compressing the covering and polishing its surface. The subject-matter of the patent designated as Division B I understand to be an article of manufacture, being an insulated telegraph wire, the covering of which has its pores filled and its surface polished, being the product which results from the use of the process of Division A. Fol. 27.

"8th Int. What can you say as to the similarities or differences between the method or the process described by you in answer to question 6 and that claimed in patent 6,954, Division A?

"A. In my opinion, they are substantially the same.

"9th Int. What can you say as to the similarities or differences between the wire marked 'Complainants' Ex. Blue Wire' and 'Complainants' Ex. Red and White Wire' and the article of manufacture or product claimed in reissue 6,955, Division B?

"A. In my opinion, the wire in each of the said exhibits possesses all the essential characteristics of the article of manufacture set forth in the claim of the patent, and is, in fact, substantially the thing so claimed.

From the foregoing it will be seen that the said exhibits are identical with the article claimed in the "Product Patent," and that, in the opinion of witness, said exhibits were made by the process claimed in the "Process Patent."

The following admission is also found in the brass company's answer:

Fol. 16. "4th. The defendant, further answering, says that it admits that it is engaged in the manufacture and sale of telegraph wire, covered by braiding over the wire a fibrous covering, after which it is dipped in a preparation for the purpose of filling and closing the pores; after which the same is sand-papered and rubbed and passed through revolving dies, for the purpose of scraping off the surplus material and consolidating and smoothening the surface of said remaining covering; but the defendant denies that in so doing, it in any way infringes upon any rights secured to the complainant by the letters patent issued to the complainant, as aforesaid, upon any proper construction of the same, and the defendant denies that it has infringed upon any just right of the complainant in any other manner."

And Mr. Pope is interrogated and answers as to said admission as follows, (page 16):

Fol. 27. "10th Int. Please state your opinion as to the similarities or differences between the method described by the defendant in its answer, as follows: 'It admits that it is engaged in the manufacture and sale of telegraph wire covered by braiding over the wire a fibrous covering, after which it is dipped in a preparation for the purpose of filling and closing of the pores, after which the same is sand-papered and rubbed and passed through revolving dies for the purpose of scraping off the surplus material, and consolidating and smoothening the surface of said remaining covering,' and the method or process described or claimed in reissue No. 6,954 Division A?

"A. The first step of the process, that of coating the wire with fibrous material, is precisely the same; as to the next step the description quoted does not state

what the material is into which the covered wire is dipped, but my inference is, from the nature of the subsequent steps in the process as they are given, and the results that are stated to be produced thereby, that the preparation so called must possess the characteristics of paraffine or wax; the purpose served by it, that of filling and closing the pores of the fibrous material, is precisely the same; the next step, that of sand-papering and rubbing the coated wire, is an additional one, not referred to in the patent; its office apparently is to remove surplus material, and, to a certain extent, to smooth the surface; the effect of this step upon the finished product would probably not be perceptible, except in so far as a less quantity of insulating material would be found upon the wire; the final step of the process in each case appears to have the same object und result, as it is obvious that consolidating the surface necessarily involves the compressing of it, and that smoothening the surface is the same thing as polishing it, the difference, if any, is merely one of degree, and not of kind."

Novelty.

The defendant alleges that the inventions claimed in the re-issues, were anticipated by certain British patents, viz.: Letters patent of Great Britain, granted to Felix M. Baudouin, dated April 3, 1857, No. 933; and letters patent of Great Britain, granted to Thomas Earl, of Dundonald, dated July 22, 1851, No. 13,698. Fol. 17.

These British patents were introduced in evidence as "Defendant's Exhibit Baudouin Patent," and "Defend-"ant's Exhibit Dundonald Patent." Fol. 53.

It was held by the court below, that these patents anticipated the claim of the "Process Patent," and also the claim of the "Product Patent," and hence, the bill was dismissed, and complainant in the court below thereupon took this appeal.

Assignment of Errors.

Appellant assigns the following errors as grounds on which the decree of the court below should be reversed:

1. The court erred in holding that the "Baudouin "Patent" and the "Dundonald Patent," describe the process or method claimed in "Complainant's Exhibit "Process Patent."

2. The court erred in holding that the said British patents anticipate the invention claimed in "Complain- "ant's Exhibit Product Patent."

3. The court erred in dismissing the bill and in not ordering an injunction and an accounting against the Brass Company.

The British Patents.

The Dundonald patent is entitled, "Sewers Drains, "Waterways, Pipes, &c." Fol. 54.

The patent, in short, describes certain uses to which bitumen may be applied. The only part of the patent that relates to insulating telegraph wires, is as follows:

"I also employ a bituminous material to cover, and thus insulate, the conducting wires of electric telegraphs, which are intended to be placed underground. For this purpose I employ the said bitumen, either simple or compounded, of a flexible description, and pass the wire through it when it is in a melted state, then causing the wire to pass through some die or orifice, which will deprive it of all superfluous bitumen, after which I pass it through water, or (which I prefer) an emulsion composed of water and clay, or water and lime, so as to deprive the surface of the bitumen of its adhesive qualities and cool it. The covered wire may then be wound upon a reel, or otherwise coil, so as to be ready for use, and in hot weather it may be desirable to do this under water. The coating of wire in this way will be more uniform if it be previously covered with some cheap filamentous material, and the impregnation of this filamentous material by the bitumen will be much facilitated by first passing the covered wire through naphtha or some other fluid bitumen or solution of bitumen. Fol. 60.

"The encasement of this wire with bitumen may also be effected by covering it with a filamentous material which has been previously saturated with melted bitumen, and then passing the wire so covered through a heated die or orifice, so as to melt or soften the bitumen upon the filamentous material, and press the whole of the coating against the wire in such a way as to cause it to form one compact continuous covering of the wire, and thus insure its insulation. Fol. 61.

"In figure 4 of the said drawings, I have shown in a transverse section, another mode of insulating electric

conducting wires, which is more particularly applicable in cases in which it may be desired to lay down several of such wires. In figures 4 and 5, H is a core, which may be made of hempen rope or any other convenient material upon which I put a thick covering I I, of flexible bitumen, either of the thickness shown in the figure or any other thickness which may be sufficient to contain the wires. This covering may be put upon the core in the same way as I cover wires, as hereinbefore described. Small longitudinal grooves 2′, 2′, 2′, 2′, being made in the periphery or surface of the bitumen by appropriate projections in a heated die or collar, through which the core H, with its covering, is drawn; the wires are then to be laid along the grooves 2′, 2′, after which I cover the whole with length of longitudinal strips of bitumen I′, I′, f, f, figures 5, in like manner, as I have described with respect to the making of tubes, such as shown in figure 3.

"In figure 6 of the said drawings, I have shown a side view of a length of a case or covering containing four conducting wires, and showing the wire protruding at each end; the end of these cases may be joined or united together in the same way as I have already described with respect to joining lengths of pipes."

The Baudouin patent relates to insulating telegraph wires, and describing the machinery for winding tape on the wires, and applying the insulating material. As the specification is quite long, I will copy here only the portion of the testimony of the Brass Company's expert, Lemuel W. Serrell, in which he makes reference to this Baudouin patent, and quotes the portions which he considers most relevant to this controversy, viz.:

"In the English patent 933, granted in 1857, the inventor describes an improvement in the wires or conductors of electric telegraphs.

Fol. 47. "Upon page 6, line 12, he states: 'I will further remark that, although I prefer bitumens for the coatings of telegraph wires, my process is equally applicable to all fatty or resinous substances, possessing sufficient insulating power, for example, to gum-lac varnishes, fatty varnishes, solutions of india-rubber, etc.'

"Upon page 10, line twenty-eight, he states, after describing the various guides and devices made use of, as follows:

"'Independent of these guides, which act as smoothers, intended to throw off the excess of bitumen with which the covered wire may be loaded, I arrange one or several smoothers, l, the function of which is to compress and regulate these successive coverings.'

"Upon page 11, lines two and three, he says:

"'I can also vary at will the nature of the coverings and also that of the coatings by having several different baths of coating material. I can also, in certain cases, use tapes, strips or bands of impermeable tissue and paper, etc., instead of the tapes or bands of cloth.'

"And he describes very fully the cotton and other coverings in the form of ribbons or tapes. Then, upon page 11, line thirty-six, he says, speaking of the covered wire:

"'In its passage from one drum to the other it passes through straightening rollers, P, then through a bath of hot bitumen, I I, or over the groove of a pulley dipping and revolving in the bath of hot bitumen, as before described, and by this means receiving a coating, the excess of which is wiped off by scrapers or smoothers, l, made of copper or other elastic material, through which it passes. The wire being thus coated, then passes through the hollow end of the axis, A, of a revolving frame, which carries three bobbins charged with tapes or ribbons, and arranged so that in turning with the frame on which they are mounted, they deposit three helicoidal turns of the tape or ribbon around the wire during its passage through the said revolving frame. The wire, after being covered, passes through the smoothers, l', which, like the frame on which the bobbins are mounted, receive a rotary motion from any motive power.'

"Upon page 11, line twenty-eight, this inventor says:

"'The same apparatus serves to obtain analogous results with other insulating preparations, such as preparations of india rubber, gum-lac, fatty oils, etc.'"

The Brass Company also introduced in evidence Fol. 84.
Letters Patent No. 22,922, granted Maynard February

8, 1856, for method of covering with fibrous material submerged spiral electrodes for short distances.

And it was admitted in the record as follows:

Fol. 53. "Parties present by their respective counsel. Defendant's counsel here produced a sample of hoop-skirt wire, which is marked 'Defendant's Exhibit, Hoop-skirt Wire, W. J. M., February 18, 1881.'

"The complainant's counsel admits that hoop-skirt wire of differing widths has been covered by fibrous materials and then run through a vat of liquid sizing, composed substantially of flour, potato starch, glue and water; after which the wire is run between heated cylinders, or heated irons, and then drawn over heated calenders, producing the result shown in exhibit marked 'Defendant's Exhibit, Hoop-skirt Wire, W. J. M., Feb. 18, 1881,' and that this process and article has been common since 1864 or 1865. The defendant's counsel admits that wire covered by that process has not been practically used for telegraph purposes, and that such covering is not waterproof.

"New York, February 18, 1881."

This is all the evidence introduced by the Brass Company which it is claimed tends to limit or anticipate the Electric Company's patents sued on.

Question raised by this Appeal.

The only question raised by this appeal is whether in view of the state of the art as it existed prior to 1872, the improvements made by Olmsted are patentable, as set forth in "Complainant's Exhibit Process Patent," and "Complainant's Exhibit Product Patent." The court below answered this question in the negative, relying upon the case of *Brown* v. *Piper*, 91 U. S., 37.

The claim in that case was: "Preserving fish or other articles in a close chamber by means of a freezing mixture, having no contact with the atmosphere of the preserving chamber, substantially as set forth."

It was proven that for years previous, corpses had been preserved in the same way, and hence the patent was declared void.

We contend that our case is clearly distinguishable from *Brown* v. *Piper*, and especially we contend that as the wire insulated according to Dundonald's and Baudouin's patents never came into public use, but on the contrary, proved a failure, their processes and products, whatever they may have been, should not be considered as anticipating the process and product invented by Olmsted, which at once were recognized by all electricians as a great advance in the art, and which at once took the market. (See testimony of Pope, Kellogg, Firman, Summers, Tubbs, Dickinson and E. M. Barton.)

The difference between this *wire* case and the *Brown* v. *Piper* fish case, is the difference between success and failure, and, I trust, in my argument I shall be able to make it appear that Olmsted made such a step in advance of that which had gone before, that your Honors will hold his patents good, and reverse the decree of the court below.

Respectfully submitted.

GEORGE P. BARTON,
For Appellant.

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} *In Equity.*

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BRIEF FOR THE DEFENDANT.

WM. B. WOOSTER,
FOR DEFENDANT.

Press of the Naugatuck Valley Sentinel, Ansonia, Conn.

Supreme Court of the United States,

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BRIEF FOR THE DEFENDANTS.

I.

The re-issue of Olmstead's Patent, on which the complainants rely, presents the asserted invention in two claims:

1. The process.

2. The product.

The answer denies the invention, and the proofs sustain the answer in the following positions:

1st. The defendants have not infringed either claim.

2nd. There was no invention in either claim or part of said re-issue, known to the patent law as the subject matter of Letters Patent.

3rd. Long before the patentee made his pretended discovery, the process was well known in the state of the art and was fully described and shown in Letters Patent of the United States and Great Britain, as will by the exhibits put in evidence appear.

The learned Judge at the Circuit disposed of this case upon the question of *Novelty*, and the appellants conceiving that the Court erred upon this point, or erred in relying upon the authorities cited by the Court in the opinion given, ask the reversal of the decree of the Circuit Court.

The claims of the plaintiff, qualified by his disclaimer, and expounded by his expert, are simply these:

1st. That before his pretended discovery telegraph wire had been made, covered with fibrous material in any of the well known modes of covering.

2nd. That such covered wire had been dipped in melted paraffine or wax or other insulating material for the purpose of closing the pores and insulating the wire.

3rd. That the surplus material, paraffine or wax, or other insulating material, had been scraped off.

4th. That this method was objectionable, inasmuch as it left the covering rough.

5th. That he in his improved method, did not scrape off, but *compressed the whole of the surplus* wax or paraffine into the covering.

He neither discovered nor claimed any device for this compressing or smoothening, but claimed every known device that did not scrape off the surplus wax, and that would compress and smoothen the paraffine or wax upon the covering.

See Plaintiffs' Ex. Olmstead's Patents, page 23, folio 40.

I. Novelty.

Long before Olmstead's claimed invention, every step, including the final or third step under his method of compressing or polishing covered and insulated telegraph wire, was well known.

On page 26, folios 46–47, Mr. Serrel, a witness of great ability and research, testifies as follows:

"I have examined carefully into the state of the art, and am aware that before the invention of Mr. Olmsted telegraph wire and cables had been covered by fibrous material, and that this fibrous material had been in the form of threads, in some instances braided or wound around the wire. That in other instances tapes or strips wound helically around the wire, and that in many instances two or more layers of such coverings had been made use of. I am also aware that insulating material such as paraffine, wax, bitumen, gutta-percha, and varnishes of different characters, had been employed as a material that would soak into the fibrous covering and accomplish two objects, the first being to unite the fibres finly together and cause them to adhere to the metal wire; the second, to exclude moisture, thereby preventing the insulation of the telegraph wire being injured by moisture coming into contact with the wire. I am also aware that the surplus coating material, such as bitumen, had been removed by a scraping or rubbing operation, and that the fibrous material had been compressed for the twofold purpose of consolidating the fibre and the bituminous material, so as to cause it to adhere to the wire, and thereby rendering the surface of the coated wire more uniform in size than it would be if simply covered with the fibrous material and its coating of wax. I refer to the patent of Edward May-

nard, in which there was a fibrous covering applied to the wire in several layers. I also refer to the English Patent 13,698, granted in 1851, in which is described a variety of devices."

See Dundonald's English Patent No. 13,698, July 22d, 1851, page 36, folio 60:

"I also employ a bituminous material to cover, and thus insulate, the conducting wires of electric telegraphs, which are intended to be placed underground. For this purpose I employ the said bitumen, either simple or compounded, of a flexible description, and pass the wire through it when it is in a melted state, then causing the wire to pass through some die or orifice, which will deprive it of all the superfluous bitumen, after which I pass it through water, or (which I prefer) an emulsion composed of water and clay, or water and lime, so as to deprive the surface of the bitumen of its adhesive qualities, and cool it. The covered wire may then be wound upon a reel, or otherwise coiled, so as to be ready for use, and in hot weather it may be desirable to do this under water. The coating of wire in this way will be more uniform if it be previously covered with some cheap filamentous material, and the impregnation of this filamentous material by the bitumen will be much facilitated by first passing the covered wire through naptha or some other fluid bitumen or solution of bitumen. The incasement of this wire with bitumen may also be affected by covering it with a filamentous material, which has been previously saturated with melted bitumen, and then passing the wire so covered through a heated die or orifice, so as to melt or soften the bitumen upon the filamentous material, and *press the whole of the coating against the wire* in such a way as to cause it to form one compact continuous covering of the wire, and thus insure its insulation."

See Baudouin's English Patent April 3rd, 1857, No. 933, page 38, folio 65:

"My invention relates to the preparation of conductors of electricity for electric telegraphs, being wires insulated to prevent the loss or deterioration of the electric currents used for that purpose, and also in the machinery for

the preparation or manufacture of such conductors. I coat the wires with bituminous or such like fatty matters that are not liable to become hard or crack, but, on the contrary, are constantly acted on by the temperature of the atmosphere. Coatings of this material in themselves are insufficient to maintain the proper protection and insulation for telegraph conductors, but when combined with other materials, such as paper, woven fabrics of cotton, silk, wool, or hemp, in a particular manner, are well adapted for the purpose." * * * * *

Folio 66:

"I prefer to use three ribbons and bobbins for this purpose, the first covering of the wire being enveloped by the second in such manner that the helical junction of the first ribbon is covered by the second, and the second by the third. The *wire is passed through a bath of hot bitumen*, and has the *superfluous matter removed by passing through suitable dies or parts* to scrape and smooth its surface, and render it of uniform thickness. The first and second ribbons are also passed through bituminous or other suitable matter to render them more impervious to electricity. The coated and lapped wire is passed through suitable dies to remove superfluous matter, to smooth down the lapping of the ribbons, and to compress and cause their proper adhesion. The ribbon reels are furnished with breaks to produce sufficient tension of the ribbon. The ribbons may be applied without any bituminous coating, or they may be coated previously to the winding." * *

Folio 67:

"The coated and lapped wire passes through dies or smoothing holes both in entering and leaving the rotating frame; these dies or smoothers have a rotary motion, the better to enable them to wipe and smooth the coated wire. The wires while under operation may either be disposed vertically or horizontally." * * * * *

"The apparatus before described may be used for coating wire with impermeable bands treated with coatings of solutions of India rubber, mixtures of tallow, rosin and other insulating compositions." * * * *

Folio 70:

"I will further remark, that although I prefer bitumens for the coatings of telegraph wires, my process is equally applicable to all fatty or resinous substances possessing sufficient insulating power, for example, to gum-lac varnishes, fatty varnishes, solutions of India rubber, etc."

The expert, Mr. Serrell, says, page 27–8, folio 48:

"In view of these statements in patents granted long prior to that of Olmstead, I am unable to discover in the patent of Olmstead, as broadly stated, anything that is novel. Olmstead admits that his invention did not relate to the use of the covering, or to the use of paraffine, or to the scraping operation, and this I find fully sustained by the state of the art; and I find also that in these patents, from which quotations have been given, that it was not new to compress or smooth the coated covering, but that, on the contrary, Baudouin, in his English patent, 933, of 1857, expressly sets forth that the covering, coated and saturated with insulating material, and names a number of those insulating materials, is to be pressed and smoothed. Thereby I understand that Mr. Olmstead was not the first party to compress or smooth any such coated covering, and that the process described by him is old, and the process being old, there is no distinguishing feature in the article resulting from that process. I am unable to imagine any difference that can be pointed out as existing in a wire, covered, coated and compressed according to Baudouin's process, and one covered, coated and compressed according to the division B of the Olmstead re-issue."

The discovery of a new effect produced by old agents operating by old means upon old subjects, however novel and important, is not patentable.

Morton vs. N. Y. Eye Infirmary, 2 Fish, 320.

S. C. 5 Blatch, 116.

Corn Planter Case, 23 Wal., 230.

Freezing Fish, Brown et. al. vs. Piper, 1 Otto., 37, 91 U. S. 41.

Turning Collars, Collar Co. vs. Van Deusen, 23 Wal., 563.

Comminuted Glue, Glue Co. vs. Upton, 7 Otto., 3.

Rubber coated harness trimming, Rubber Coated Harness Trimming Co. vs. Welling, 7 Otto., 10.

Lead pencil tips, Rockendorfer vs. Faber, 2 Otto., 347.

Justice Schesen in Fricke vs. Hum, 22d Federal Reporter, 304, says:

"I am by no means prepared to admit that there was any patentable novelty in the manufacture of three or four strand copper-wire cable, for such cable differs in material only from ordinary hemp rope."

See also Phillips vs. Detroit, 111 U. S. 604.

II.

The judgment of the Circuit Court should not be reversed if the case shows, that for any reason the complainant cannot maintain the action, even though the Judge at the Circuit should have erred upon the question of Novelty.

The specifications and proofs of the complainants disclose no invention or discovery patentable.

The claims of the Patentee, qualified by his disclaimer and expounded by his expert, are these:

1st. That before his pretended discovery telegraph wire had been made, covered with fibrous material in any of the well known modes of covering.

2nd. That such covered wire had been dipped in melted paraffine or wax or other insulating material for the purpose of closing the pores and insulating the wire.

3rd. That the surplus material, paraffine or wax, had been scraped off.

4th. That this method was objectionable inasmuch as it left the covering rough.

5th. That he, in his improved method, did not scrape off, but compressed the whole of the surplus wax or paraffine into the covering.

He neither discovered nor claimed any device for this compressing or smoothening, but claimed every known device that did not scrape off the surplus wax, and that would compress and smoothen the paraffine or wax upon the covering.

See Plaintiffs' Ex. Olmstead's Patents, page 23, folio 41.

The plaintiffs' expert states broadly the plaintiffs' claim on folios 30 and 31, pages 18 and 19.

"21st *Int.* Do you understand the claim to cover any particular mode of compressing the covering of wire, and thereby polishing it, or does it include every mode by which compressing and polishing can be obtained on a plastic or insulating material?

(Question objected to as indefinite.)

"*A.* I construe it to include any mode of compressing the covering, as compressing is a certain well known process, and the specification has pointed out one means of effecting the compression which will produce the result aimed at, it is not necessary to undertake to point out all the different methods that might be used.

"22d *Int.* Does the claim include wire covered by the material you have named, if the surface is not polished?

"*A.* In my opinion, it does, if the covering has been compressed as described in the specification. The principal object of the process is, I understand, to improve the insulation of the wire, and this is effected by the compression. The polishing of the surface is incidental to the compression described, but it aids to some extent in securing good insulation, as the polished surface retains less moisture after having been wet than does a surface which is less smooth.

"23d *Int.* If a wire, after covering with fibrous material and filling with wax, paraffine, or other plastic substance, which you include under the claim, were drawn through a person's hand closed, so as to compress the wire and thereby smoothen the insulating substance on the wire, would that process be included under the claim, as you construe it?

"*A.* I should say not.

"24th *Int.* Give your reasons why not?

"*A.* The specification of this patent, before describing the improved process which forms its subject-matter, sets forth the objection to the method previously in use, viz., that it leaves the covering in a very rough and soft condition, and fails to secure perfect insulation. I infer from this that the improved process is designed to smoothen and harden the covering, and thereby improve the insulation; therefore, I understand the term suitable machine, by a fair construction, to mean an instrumentality which presents a hard and smooth surface to the coating of the wire during the operation, which a person's hand would not be.

"25th *Int.* If in the hand were held a metallic or wooden die, through which the wire was drawn, and this imparted to the covering a polished surface and it compressed the plastic substance into the fibrous covering, would this process, as you construe the claim, be covered by it?

"*A.* I think it would be substantially the same as the final step of the process claimed.

"26th *Int.* If within the hand you held any substance of sufficient solidity to compress the plastic material, and thereby polish, and such substance was by the hands compressed around the wire and the wire drawn through, would or not that be within the claim, as you understand it?

(Objected to as indefinite.)

"*A.* The meaning of the question is not quite clear to me. The term sufficient solidity does not convey a clear impression to my mind as to the physical characteristics of the substance intended.

"27th *Int.* Question twenty-six is repeated, with this addition—the substance to be held in the hand shall be harder than the plastic substance on the wire, and shall be so hard as not to yield to such plastic substance, and shall be so smooth as to polish when the wire is drawn through the hand and between the substance compressed around the wire?

(Objected to as indefinite, and as a repetition of question twenty-five so far as its meaning is apparent.)

"*A.* I am of the opinion that this operation would also be substantially the same as the final step of the process claimed."

It is admitted that every step was well known except the fact of "compressing and thereby polishing its surface," and

That scraping in all its form was well known, and this wire thus manufactured was common, but it is claimed that the *compressing and thereby polishing the surface* was his discovery.

The patent, construed as the plaintiff claims, would make every person an infringer who should take any well known article of covered and dipped wire found in the market and draw the same between the fingers so as to compress and thereby polish the surface.

The invention in both its parts claims exactly this as the invention, or it claims nothing.

What thought, what inventive genius was invoked beyond the thought and discovery of the first woman who ever drew a wax thread between her fingers?

In the language of Mr. Justice Swayne, in Densmore *vs.* Scofield, 19 O. G., 289: "It does not appear that there

was a *flash* of thought by which such a result was reac d or that there was any exercise of the inventive faculty, more or less thoughtful, whereby anything entitled to the protection of a patent was produced."

The proof that this is the final process is demonstrated by any person taking the covered wire dipped in paraffine and wax and without the removal of one grain of the wax or paraffine, draw the same through the hand, or between thumb and finger, and you have both the *method* or process claimed in Division A, and the insulated wire claimed in Division B.

Again, if the plaintiffs' process produces an insulated telegraph wire that is the same as the insulated telegraph wire produced by scraping off the surplus paraffine or wax with or without any other process of compressing or polishing than the die or process used for scraping off the surplus paraffine or wax, then the product or wire which the inventor claims is not new.

Does such scraping produce such wire? or does such scraping off of surplus wax and paraffine and then smoothening the wire with the coating remaining thereon, produce such wire?

The plaintiff's witness Pope, page 16 on folio 28, says: "The sandpapering and rubbing of the coated wire is an additional one not referred to in the patent; its office apparently is to remove the surplus material, and to a certain extent to smooth the surface; the effect of this step upon the finished product would probably not be perceptible, except in so far as a less quantity of insulating material would be found upon the wire."

Mr. Serrell by a series of experiments, shown in his testimony on defendant's case, page 51, folios, 84-90, and the exhibits produced by said witness, demonstrates that the process of scraping off the surplus paraffine or wax leaves the coating of the wire in a smooth and polished state.

That wire after having been covered and dipped, whether subjected to the scraping process without any compression, or run through the revolving dies of the defendants in their process of manufacture, presents the same appearance and is identically the same wire.

No new article of manufacture is produced by the process claimed in the plaintiffs' patent.

Invention is not found in *smoothening* the *whole wax* that *adheres to wire* as it cools. The process of compressing and polishing is the same and identical whether a part is removed by scraping, or whether the polishing takes place without removing the surplus. The product or result is identical, except that the one may be more bulky and may be better insulated. "The difference, if any (as the witness Pope says, folio 28), is merely one of degree and not of kind."

He says: "the final step of the process in each case appears to have the same object and results, as it is obvious that consolidating the surface necessarily involves the compressing of it and that smoothening the surface is the same thing as polishing it, the difference, if any, *is merely one of degree, and not of kind.*"

But this is not the subject of a patent.

In Smith *vs.* Nichols, 21 Wal. 112, where a patent for an improvement in weaving elastic fabric was declared invalid, the court says, "It is the invention of what is *new*, and not the arrival at comparative seperiority or greater excellence in that which was already known, which the law protects."

"A mere carrying forward, or new, or more extended application of the original thought, a change only in form, proportion, or *degree*, the substitute of equivalents, doing substantially the same thing in the same way by substan-

tially the same means with better results, is not such invention as will sustain a patent."

Smith *vs.* Nichols, 21 Wal., 119.

III.

As to the alleged infringement:

The specifications in both parts of the re-issue are identically the same. The two parts differ in nothing but the claims. Division A claims the "method" or process; Division B, the "product."

Long before the application of Olmstead for a patent (July 23d, 1872), insulated telegraph wire had been made and Olmstead describes in his specifications what he claims to be the difference.

See folios 36 and 42.

"The method of insulating now in use consists in braiding over the wire a fibrous covering, after which it is dipped in wax, for the purpose of filling and closing the pores, and, after a subsequent scraping to remove the surplus wax, it is ready for use. This method is, however, objectionable, inasmuch as it leaves the covering in a very rough and soft condition, and fails to secure perfect insulation."

The only difference stated is this: He asserts that prior to his discovery "scraping" was resorted to to remove the surplus wax.

This method, he says, is objectionable. He then says: I *pass the whole* through a suitable machine, which compresses the covering," etc.

The only claimed difference lies in the "scraping to remove surplus wax," and "instead of scraping off the surplus coating, I *pass the whole* through a suitable machine,

which compresses the covering and forces the paraffine or wax into the pores."

The old process, as stated by him, simply *removed the surplus* wax or paraffine.

His claimed improvement in his process, of course included passing all surplus wax or paraffine through a compressing machine and pressing all into the fibrous covering. The product differed, as he claims, only as the reresult of the two processes differs.

What is the proof as to the acts of the defendant?

In paragraph 4 in defendants' answer, found on page 8 of the record, the defendants states its case as follows: That it is engaged in the manufacture and sale of telegraph wire, covered by braiding over the wire a fibrous covering, after which it is dipped in a preparation for the purpose of filling and closing the pores; after which the same is sand papered and rubbed and passed through revolving dies, for the purpose of scraping off the surplus material and consolidating and smoothening the surface of said remaining covering."

The only evidence offered of the process of the defendant in making its wire is found in the testimony of the plaintiffs' witness, Pope, in his answer:

Folios 27 and 28, page 16.

"The first step of the process, that of coating the wire with fibrous material, is precisely the same; as to the next step, the description quoted does not state what the material is into which the covered wire is dipped, but my inference is, from the nature of the subsequent steps in the process as they are given, and the results that are stated to be produced thereby, that the preparation so called must possess the characteristics of paraffine or wax;

the purpose served by it, that of filling and closing the pores of the fibrous material, is precisely the same; the next step, that of sandpapering and rubbing the coated wire is an additional one, not referred to in the patent; its office apparently is to remove surplus material, and, to a certain extent, to smooth the surface; the effect of this step upon the finished product would probably not be perceptible, except in so far as a less quantity of insulating material would be found upon the wire; the final step of the process in each case appears to have the same object and result, as it is obvious that consolidating the surface necessarily involves the compressing of it, and that smoothening the surface is the same thing as polishing it, the difference, if any, is merely one of degree, and not of kind."

The only other evidence of infringement is found in complainants' Exhibit Blue Wire, and Red and White Wire.

Pope does not controvert, in his answer, that in the manufacture of the defendants "the surplus material is scraped off," nor does he even suggest to the contrary.

No claim is made that the defendants ever made or sold a pound of wire without first scraping off the surplus material by the process stated in the answer.

The wire exhibits do not tend to controvert this position.

Pope, the witness, page 16, folio 28, interogatory 10, says, "the effect of this step (scraping off surplus material), upon the finished product would probably not be perceptable, except in so far as a less quantity of insulating material would be found upon the wire."

The defendant's witness, Serrell, page 52, folio 85, says: "I found that the machine made use of by the defendants

scraped off from the covered and coated wire the surplus paraffine or wax, and that it reduced the wire to the same size, or nearly so, as the hole in the scraping tube No. 4. I here produce some of the chips scraped off by this machine, the surplus paraffine removed from the covering."

See defendant's Ex. 9.

See also, answer on page 53, folios 87 to 90 of the record.

Without extending this examination of the testimony farther, we submit that there is not the slightest evidence in the case showing or tending to show that the defendants have ever made or sold wire with all the surplus paraffine or wax compressed into the fibrous covering, or that they have ever made or sold any insulated telegraph wire dipped in any insulating material without scraping to remove all surplus wax, and

That the defendants have never made or sold a pound of wire that was not in its process of manufacture treated exactly as Olmstead, in his specification, specifies as the state of the art at the date of his application.

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